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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,886	08/20/2003	Paul E. Jacobs	000373D3	8188
23696	7590	01/07/2005	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,886

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/30/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 7/30/2004.
2. Claims 1-19 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113, 126-127, 136-137 and 146 of copending Application No.09/679,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

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4. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

5. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

6. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition. Since, monitoring and displaying various advertisements which can occupy the entire portion of the display along with banner advertisements is obvious in on-line advertisements then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included detecting if a displayed advertisement such as a banner advertisements is being obscured by an advertisement and notifying the user in order for the user to be aware that might not be compensated for viewing the banner advertisements that is being obscured by the advertisement.

7. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62 of copending Application No.09/668,331. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

8. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-70 and 74-76 of copending Application No.09/668,632. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites an e-mail function for receiving and sending e-mail to other client devices. Sending and receiving e-mail to other clients is old and well known in the computer related arts in order to receive messages immediately from other clients. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

9. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-70, 74-76 and 78 of copending Application No.09/668,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application further recites three operating modes. Different operating modes such as Online and offline operating modes are known in the computer related arts in order to

provide different states of the program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

10. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9-11,14-24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending Application No.09/668,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

11. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No.09/668,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites a third operating mode in which the software switches the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another

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operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Montague (6,298,332 hereinafter Montague).

With respect to claims 1, 7, 13-15 Marsh teaches software for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network (Abstract). An advertisement download function that downloads advertisements from at least one remote source, during one or more advertisements download sessions (see figure 4, item 601); an advertisement

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store function that stores the download advertisements on a storage medium associated with the client device (col. 14, lines 1-10); an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device (Figure 6, 702); an audit function that compiles as-related statistical data relating to the downloaded advertisements, wherein the ad-related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval (col. 14, lines 66-, col. 15, lines 1-7); an audit data transmit function that transmits the ad-related statistical data to a prescribed server system (Figure 8 and col. 15, lines 10-20).

Marsh teaches sending the statistical data to the server (Figure 8 and col. 14, lines 66-, col. 15, lines 1-20). Marsh does not specifically teach sending the data only in response to a user's grant permission to do so. Montague teaches delivering vendor-supplied information to a purchase, while the purchaser authorizing transmission of various data to a vendor server or a third party server (col. 9, lines 20-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Marsh the teaching of Montague of sending the data only in response to a user's grant permission to do so because such a modification would allow the users to have controlled of the data that is transmitted.

With respect to claims 2-3 , Marsh further teaches that the prescribed rollover intervals correspond to the prescribed audit intervals (col. 3, lines 12-27 and col. 7, lines 7-24). With respect to claims 4-6, Marsh further teaches under a client policy

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transmitting a statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-27 and col. 7, lines 7-24).

With respect to claim 8, Marsh further teaches that the advertisement distribution server system is managed by a producer of the software (col. 3, lines 12-56).

With respect to claims 9, Marsh further teaches that the advertisement distribution server system is managed by a distributor of the software (col. 3, lines 12-56).

With respect to claim 10, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claim 11, Marsh further teaches that the software is e-mail software (see Figure 8).

With respect to claim 12, Marsh further teaches that the client information includes user demographic data and transmitting the information to the prescribed server system (col. 3, lines 12-27).

With respect to claim 16, Marsh further teaches that advertisement display function effects display when the client device is offline (col. 6, lines 63-, col. 7, lines 1).

With respect to claim 17, Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

Claims 18-19 further recite that the audit data is transmitted at activated random times. Marsh teaches transmitting audit data (col. 14, lines 66-, col. 15, lines 1-7). Marsh does not specifically teach transmitting the audit data at random times. Official

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notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.

Response to Arguments

13. With respect to the double patenting rejection, Applicant is reserving response to the provisional rejections until all other issues of patentability are settled in both applications. Therefore the double patenting rejection is sustained.

14. Applicant argues that Marsh doesn't teach an advertisement download function that is for use in software for use on a client device. The Examiner disagrees with Applicant because Marsh teaches downloading and presentation of advertisements on a client device, If the advertisements are downloaded and presented to the user on a client device then the client device must contain some sort of advertisement download function to install the software or program to enable the presentation of the ads to take place.

15. Applicant argues that the references do not teach " a send audit data display window that requests the user's permission to transmit ad-related statistical data to the prescribed server system". The Examiner respectfully disagrees with Applicant because Marsh teaches on col. 14 lines 66 to col. 15 lines 1-20 that the statistics log file is stored in storage 101 and that is sent to sever system 104, which uses the statistics to determine which advertisements to subsequently present to the user. Furthermore, Montague clearly teaches on col. 9, lines 20-24 that "a user can selectively authorize

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transmission of various data to a vendor or an independent third party server according to only authorizations selected by a user". Therefore the combination of Marsh and Montague teaches "the audit data transmit function transmits the ad-related statistical data only in response to user's grant permission to do so" .

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., protection of the user's privacy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. In response to applicant's argument that the user's permission is to protect the privacy of the user, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

18. The Applicant has focused on the statistical data being used for billing purposes and has overlooked the additional teachings of the "information can also be used at the server system 104 by the advertisement distributor scheduler and the advertisement download scheduler" (col. 15, lines 9-13) in order to determine which advertisement to subsequently present to the user (col. 15, lines 7-9). "The advertisement distribution scheduler is located at the server system 104" (col. 15, lines 31-53). Therefore, the ads viewed by the user are not only sent for billing purposes but also to target future ads.

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19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marsh and Montague can be easily combined to send only data in which a user has grant permission to do so because such a modification would allow the user to have control of the ads that are being targeted to him or her.

20. With respect to claims 2-3, Applicant argues that Marsh doesn't teach sending the audit data at prescribed intervals. The Examiner disagrees with Applicant because Marsh clearly teaches transmitting the statistical data periodically (In marsh steps 740, 902 and 909).

21. With respect to claims 4-6, Applicant argues that Marsh doesn't teach a client policy for transmitting the statistical data at prescribed times. The Examiner respectfully disagrees with Applicant because Marsh teaches that the user allows the system to collect statistical information such as user's hobbies, interest employment, etc. this information is collected and passed on to the server system (col. 3, lines 12-27). Therefore, a client policy exists to allow the data to be collected and transmitted.

22. With respect to arguments to claims 8 and 19, the Applicant has agreed with Examiner that performing a function at the random is old and well known in the

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computer related arts to avoid general data problems. Nevertheless, Applicant argues that in instant application, the performing of the random function is not directed to software problems. The Applicant is reminded that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

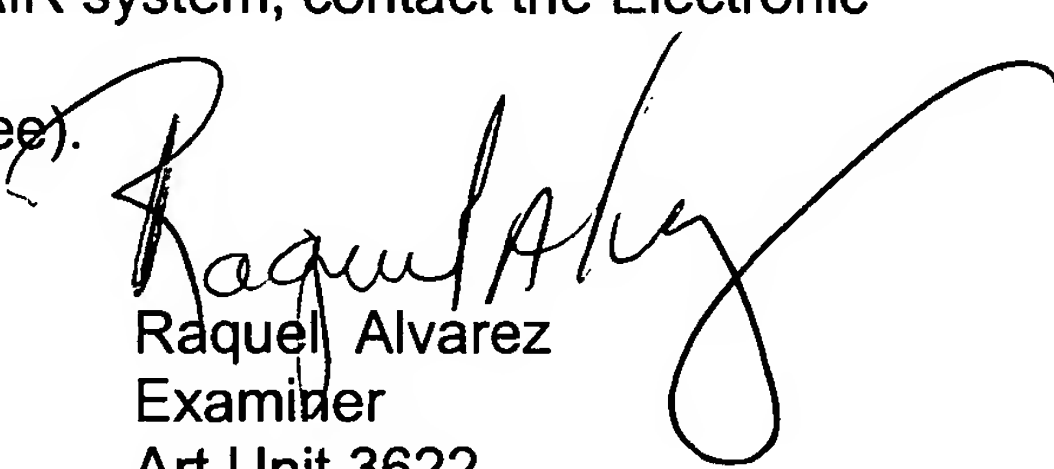
Point of contact

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Examiner
Art Unit 3622

R.A.
12/29/04